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Application Serial No. 09/386,850
Attorney's Docket No. 004900-169

REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claim 17 has been canceled without prejudice or disclaimer to the subject matter recited therein. Applicants reserve the right to file a continuation application drawn to the canceled subject matter. Accordingly, no new matter has been added.

I. Rejections Under 35 U.S.C. § 101 and § 112, first paragraph

Claims 15-17 have been rejected under 35 U.S.C. § 101 because the claimed invention is allegedly not supported by either a credible utility or a well established utility. Further, claims 15-17 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse these rejections.

Applicants submit that the peptides of the subject invention are useful for evaluating androgen activity. More specifically, the claimed peptides are useful as biological markers for evaluating the androgen and anti-androgen activity of new drugs to be tested in preclinical trials.

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A similar rejection under 35 U.S.C. § 112, first paragraph was raised by the Examiner in corresponding U.S. Application Serial Nos. 08/153,277 and 08/476,120. In the corresponding applications, Applicants filed a Declaration by Isabelle Rosinski-Chupin, one of the inventors of the subject matter disclosed in the present application. Applicants have enclosed herewith a copy of said Declaration in response to the above-referenced rejection.

In the Declaration, Dr. Rosinski-Chupin declares that the disclosure of the subject application teaches the high degree of induction of the SMR1 gene by androgens. See, for example, page 12, lines 29-30 of the specification. Hence, the accumulation of the claimed peptides is correlatable to androgen activity and thus useful as markers for androgen activity. Therefore, in light of the teachings of the present specification, it is apparent that the skilled artisan would have a reasonable expectation of success in utilizing the claimed peptides for this purpose. Furthermore, in the Declaration, Dr. Rosinski-Chupin provides additional experiments which evidence the usefulness of the claimed peptides for evaluating androgen activity.

Accordingly, the disclosure of the present application provides a credible and/or a well established utility and the application is fully enabling and teaches the skilled artisan how to use the claimed invention without undue experimentation.

In view of the above, the Examiner is respectfully requested to withdraw both of the rejections of claims 15-17 under 35 U.S.C. § 101 and § 112, first paragraph.

II. Rejections Under 35 U.S.C. § 112, second paragraph

Claims 15 and 16 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this rejection.

The Examiner has stated that claims 15 and 16 recite the term "hybridize" without limitations directed to the stringency of the hybridization. Applicants submit that hybridization of a probe to nucleic acid is within the purview of those skilled in the art. Applicants also submit that the conditions for nucleic acid hybridization are well known in the art as evidenced by Sambrook et al., *Molecular Cloning: A Laboratory Manual*, 2d Edition, Cold Spring Harbor Laboratory Press, N.Y. (1989). Further, page 8, lines 20-32, of the specification provides hybridization conditions for hybridizing a probe to RNA. Therefore, Applicants submit that the skilled artisan would understand what is meant by the term "hybridize."

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. § 112, second paragraph.

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.


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In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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